



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,810	07/14/2000	Leslie G. Fritzemeier	05770-095001	6592

7590

08/27/2002

Gary A Walpert  
Fish & Richardson PC  
225 Franklin Street  
Boston, MA 02110-2804

EXAMINER

CUNEO, KAMAND

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

9/6/6 810

Applicant(s)

Examiner

Cunoo

Group Art Unit

2827

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-106 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-106 are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Serial Number: 09/616810  
Art Unit: 2827

2

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30, drawn to a composition, classified in class 505, subclass .
  - II. Claims 31-56 and 71-79, drawn to a method, classified in class 29, subclass 599.
  - III. Claims 57-70 and 80-106, drawn to a product, classified in class 174, subclass 125.1.
2. The inventions are distinct, each from the other because of the following reasons: Inventions II and I,III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by the powder-in-tube method.
3. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed such as the salts and concentrations claimed. The subcombination has separate utility such as a conducting composition.
4. Because these inventions are distinct for the reasons given above and have acquired a separate

status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Also because these inventions are distinct for the reasons given above and the search required for one of the groups is not required for the other groups, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention: .

1. figure 1,
2. figure 1 with buffer layer (page 13),
3. figure 1 with a plurality of buffer layers (page 14),
4. figure 1 with an intermediate layer (page 17),
5. figure 2,
6. figure 2 with layer (16) being superconducting (page 37),
7. figure 3 with layers (16) and (18) being buffer,
8. figure 3 with layer (16) and (18) being superconducting (page 41),
9. the article with three buffer layers as stated in paragraph 2 of page 41,

Further, each of the above 12 species may include one of the following features as described in the specification.

- a. the article having a cap layer with one layer,
- b. the article with a cap layer having more than one layer (page 43),
- c. the article having local breaks (paragraph 2 of page 43),
- d. normal metal layer sealing the conductor films (paragraph 3, page 43)

- e. superconducting layers having multiple segments across the width (paragraph 2, page 44)
- f. superconducting layers having multiple segments across the length (paragraph 3, page 44)
- g. superconducting layers having multiple segments across the width and length (paragraph 4, page 44)
- h. superconducting layers having multiple segments with insulating material between the layers (last paragraph, page 44)
- i. superconducting layers being connected at their edges (first paragraph of page 45),
- j. conductors helically wound (paragraph 1, page 45),

Therefore a species identification of 2a includes the configuration of species 2 (figure 1 with buffer layer) and one cap layer.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant

Serial Number: 09/616810  
Art Unit: 2827

5

must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. A telephone call was not made to request an oral election due to the complexity of the requirement.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Any inquiries related to the examination of this application should be directed to Ex. K. Cuneo at (703) 308-1233 or her supervisor SPE David L. Talbott at (703) 305-9883. Inquiries of a general nature should be directed to the receptionist of Group 2800 at (703) 308-0956. The fax numbers for Group 2800 are (703) 308-7722 and 7724.



K. Cuneo  
Primary Examiner  
August 26, 2002